THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN S. HONECK and COLIN R. SMIDSTRA

Appeal No. 1999-2032
Application No. 08/661,303[1]

ON BRIEF

Before COHEN, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 5, 8, 9, 11 to 19, 21 to 26, 28 to 33 and 35 to 39.[2] Claims 6, 7, 10, 20, 27 and 34, the remaining

[1] Application for patent filed June 13, 1996.

[2] While the examiner has approved entry of the amendment after final rejection to claims 2 and 22 (Paper No. 9, filed September 21, 1998), we note that this amendment has not been clerically entered.

claims pending in this application, have been objected to as depending from a non-allowed claim.

We REVERSE.

BACKGROUND

The appellants' invention relates to a non-volatile memory system for use in a vehicle (specification, p. 1, lines 3-4). An understanding of the invention can be derived from a reading of exemplary claims 1, 2, 15, 22 and 30 (the independent claims on appeal), which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ahlberg	4,570,228	Feb. 11, 1986
Esmer et al. (Esmer)	5,161,311	Nov. 10, 1992

Claims 1 to 5, 8, 9, 11 to 19, 21 to 26, 28 to 33 and 35 to 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ahlberg in view of Esmer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted

rejection, we make reference to the answer (Paper No. 15, mailed February 22, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 14, filed December 30, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 5, 8, 9, 11 to 19, 21 to 26, 28 to 33 and 35 to 39 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The teachings of Ahlberg and Esmer are set forth on pages 3-5 of the answer and on pages 6-7 of the brief. The examiner ascertained (answer, p. 4) that Ahlberg fails to "teach that the memory for storing the data (vehicle speed) is a nonvolatile memory." With regard to this difference, the examiner determined (answer, pp. 4-5) that it would have been obvious to one skilled in the art to have modified

> the vehicle accessory of Ahlberg by incorporating the nonvolatile memory of Esmer et al because such a modification will provide a memory in which data stored will be retained even in the event of a power failure and will reduce the periodic writes in the memory, thereby increasing the life of the memory.

The appellants argue (brief, pp. 8-10) that there is no motivation in the applied prior art for combining the teachings of Ahlberg and Esmer to arrive at the claimed invention. We agree. The mere fact that the prior art may be modified in the manner set forth by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Thus, teachings of the applied prior art can be combined only if there is some suggestion or incentive to do so. Here, the applied prior art contains none for the reasons set forth on pages 8-10 of the brief. In our view, the only suggestion for modifying Ahlberg in the manner proposed by the examiner to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock,

Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 to 5, 8, 9, 11 to 19, 21 to 26, 28 to 33 and 35 to 39.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 5, 8, 9, 11 to 19, 21 to 26, 28 to 33 and 35 to 39 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)
JEFFREY V. NASE Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)

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APPEAL NO. 1999-2032 - JUDGE NASE
APPLICATION NO. 08/661,303

APJ NASE

APJ COHEN

APJ GONZALES

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 12 Nov 99

FINAL TYPED: